



GOVERNMENT OF PUERTO RICO
DEPARTMENT OF STATE



February 11, 2023

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San Juan, PR 00917

SUBJECT MATTER
MARK
CLASS
FILING NUMBER
FILING DATE
APPLICANT

Office Action
DECATHLON
009
248787-09-0
July 20th, 2022
DECATHLON

To whom it may concern:

In order to proceed with the examination of the said mark Applicant must submit the following information:

- ☒ 1. Clearly state the goods and/or services in connection with the mark as used or intended to be used in commerce in Puerto Rico. This applies if the Applicant customized the selection of goods or services.

The Application in reference includes a broad and indefinite description of the goods and/or services in which the trademark will be used. A written application must specify the particular goods and/or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. To "specify" means to name in an explicit manner. The identification should set forth common names, using terminology that is generally understood. The identification of goods and/or services must be specific, definite, clear, accurate, and concise. *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), rev'd on other grounds, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *The Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), modified without opinion, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974).

Applicant identifies and classifies the goods and/or services as follows:

- "Scientific, optical, measuring, signaling, checking (supervision), life-saving apparatus and instruments; protective helmets for sports, goggles for sports, cases for spectacles, distance measuring apparatus, satellite navigation systems, namely a global positioning system (GPS), personal protection devices for use against accidents. Downloadable virtual goods, namely, computer programs relating to sports equipment, sporting and gymnastic articles, bicycles, tents, cosmetics, helmets, sports goals, snowshoes, ski equipment, surf equipment, golf clubs, lighting, watches, exercise machines, balls, swimming equipment, food, beverages, footwear, clothing,

headgear, eyewear, bags, games, toys and accessories for use in the metaverse and other online virtual environments; virtual reality game software” in International Class 009.

The wording in the identification of goods and/or services needs clarification because it is too broad and could include goods and/or services classified in other international classes. Applicant must clarify the identification of goods and/or to specify the nature of the goods as well as their main purpose and their particular field of use or channels of trade. The applicant may aid in clarifying the indefinite term by following the indefinite subject matter with “namely, [specify goods and/or services by generic or common commercial name and field of use].” Any modification to this wording must identify goods and/or services in properly classified in the original International Class specified in the application for these goods and/or services.

Applicant may substitute the following wording:

- **“SCIENTIFIC, OPTICAL, MEASURING, SIGNALING, CHECKING, AND LIFE-SAVING APPARATUS AND INSTRUMENTS, NAMELY, VEHICLE SIMULATORS, VEHICLES TEST STANDS AND VEHICLE MECHATRONICS IN THE NATURE OF INFORMATION INTERCHANGING HARDWARE/SOFTWARE MODULES;** protective helmets for sports; goggles for sports; cases for spectacles **AND SUNGLASSES;** distance measuring apparatus; satellite navigation systems, namely a global positioning system (GPS); personal protection devices for use against accidents, **NAMELY, DUST PROTECTIVE GOGGLES AND MASKS;** Downloadable virtual goods, namely, computer programs **FEATURING** sports equipment, sporting and gymnastic articles, bicycles, tents, cosmetics, helmets, sports goals, snowshoes, ski equipment, surf equipment, golf clubs , lighting, watches, exercise machines, balls, swimming equipment, food, beverages, footwear, clothing, headgear, eyewear, bags, games, toys and accessories for use in the metaverse and other online virtual environments; **DOWNLOADABLE** virtual reality game software; **RECORDED COMPUTER VIRTUAL REALITY GAME SOFTWARE”** in International Class 009; if accurate.

Be advised that this amendment is illustrative and not exhaustive.

The Applicant is referred to the International Classification of Goods and Services under the Nice Agreement provided by the World Intellectual Property Organization for assistance in describing the specific goods in relation to which the Applicant uses the mark in commerce. For a list of the latest Nice Classification of goods you can access the following website:

<http://www.wipo.int/classifications/nivilo/nice/index.htm?lang=EN>

Please note that, while an application may be amended to clarify or limit the identification of services, adding to or broadening the scope of the services is not permitted. Therefore, applicant may not amend the identification to include any services that are not within the scope of the services set forth in the present identification.

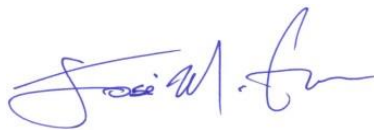
- ☐ 2. Provide a drawing of the mark as used or as intended to be used in commerce in Puerto Rico.
- ☐ 3. Provide a detailed description of the mark as used or as intended to be used in commerce in Puerto Rico.
- ☐ 4. Provide a specimen that shows the mark in connection with the goods or services identified in your application.

- ☐ 5. Applicant must disclaim those terms or components of the mark which are not susceptible of exclusive appropriation.
- ☐ 6. The registration for the applied mark is refused on the following grounds:
- ☐ 7. Other.

According to Rule 27 of Puerto Rico's Trademark Rules of Procedure, if the PRTO does not receive a response to the abovementioned remarks within ninety (90) days, the Application shall be considered abandoned.

Note: Please refer to the name of the Examining Attorney. The office action response shall be filed online at <https://prtmfiling.f1hst.com/>. Please select "RESPUESTA A NOTIFICACION" from the dropdown menu. The cost of said filing is \$15.00. If any questions should arise, you can contact the Examining Attorney at jtorres@estado.pr.gov or marcas@estado.gobierno.pr

Cordially,

A handwritten signature in blue ink, appearing to read "José M. Torres".

José M. Torres, Esq.
Examining Attorney
Puerto Rico Trademark Office